

### **REMARKS**

Claims 1-12 are pending in the Office Action and have been rejected. Claims 1, 5, and 9 are independent claims. Claims 2-4, 6-8, and 10-12 are dependent claims.

#### **Rejections Under 35 U.S.C. § 101**

In numbered paragraph 4 on page 2 and in numbered paragraph 8 on page 5 of the Office Action, the Examiner rejected claims 1-12 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Also, in numbered paragraph 9 on pages 5 and 6 of the Office Action, the Examiner rejected claims 1-12 under 35 U.S.C. § 112, first paragraph, "because current case law ... require such a rejection if a 101 rejection is given ..." Applicants respectfully traverse these rejections for the reasons presented below.

The Examiner has asserted that the amendments of the claims results in the user now controlling the process, and that requiring user inputs creates uncertainty because one user input will differ from another user input, and that a patent cannot be developed around a user response.

The Examiner asserted on page 5 of the Office Action that requiring user inputs creates uncertainty and violates "the principal of concreteness." The Examiner has not provided support for his assertions. It is requested that the Examiner provide support, such as a citation to the MPEP or case law, for his assertions that requiring user inputs in a claim creates uncertainty and violates "the principal of concreteness."

Also, an invention as a whole must produce a useful, concrete, and tangible **result**. See *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998) and MPEP § 2106 at p. 2100-6. It is submitted that producing causes with high correlation does produce a useful, concrete, and tangible result.

Further, it is respectfully submitted that merely having user input in a claim does not automatically create uncertainty. Applicants submit that numerous patents have been issued that provide for user input in the claims. One example includes the following:

“1. A method for creating a business simulation utilizing a rule-based expert system with a spreadsheet object component that includes data and calculations required for the business simulation and communication of information to provide a dynamic, goal based educational learning experience, comprising the steps of:

(a) accessing the information in the spreadsheet object component of the rule-based expert system to retrieve indicia representative of a goal and presenting the goal on a display;

(b) utilizing the information in the spreadsheet object component of the rule-based expert system to retrieve indicia representative of a goal and presenting the goal on a display;

(c) **monitoring answers to questions posed** to evaluate progress of a student toward the goal utilizing the spreadsheet object component of the rule-based expert system and providing dynamic, goal-based, remediation learning information feedback from a remediation object components a knowledge system and a software tutor comprising an artificial intelligence engine which generates individualized coaching messages that further assists the student in accomplishing the goal;

(d) **analyzing the input from the student** utilizing system tools to compare the input with a standard for achieving the goal: and

(e) providing a dynamic toolbar on the display to assist the student with achieving the goal the dynamic toolbar configured and displayed based upon information stored in the spreadsheet object component” (emphasis added).

See U.S. Patent No. 6,085,184.

Another example includes the following:

“9. A method of generating a hardware description for generating synthesizable hardware operation description that is used to synthesize an interface checking block that checks input/output signals to/from each

component block of a logical integrated circuit on which a plurality of logic circuit component blocks are connected and installed for conformity of the signals to their specifications, said method comprising the steps of reading timing interface information for signals in accurate synchronization with clock cycles of a block to be checked by the interface checking block after synthesizing on said integrated circuit and executing syntax analysis; ... simplifying the deterministic finite state machine representation per function, showing a list of functions; **allowing the user to select from the list of functions; integrating deterministic finite state machines of all functions selected by the user into one new non-deterministic finite state machine; ...** (emphasis added). See U.S. Patent No. 6,708,322.

A third example includes the following:

“3. A method for processing a datastream, the method comprising the computer-implemented steps of: automatically scanning a datastream; automatically detecting, in the datastream, a term that does not match an indexed term or word in a dictionary or glossary; **in response to user input**, identifying the unmatched term as a correctly spelled new term; **in response to user input**, receiving at least one definition of the new term; automatically storing the new term and the at least one definition of the new term as an entry in a glossary; and automatically placing the at least one definition from the glossary at an at least one user selectable location within a datastream” (emphasis added). See U.S. Patent No. 6,708,311.

Other examples include U.S. Patent No. 6,708,336, U.S. Patent No. 6,708,155, U.S. Patent No. 6,708,111, and U.S. Patent No. 6,707,985.

Thus, it is submitted that claims 1-12 meet the requirements of 35 U.S.C. §§ 101 and 112, first paragraph. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under §§ 101 and 112.

**Rejections Under 35 U.S.C. § 102**

In numbered paragraph 10 on page 6 of the current Office Action, the Examiner stated that the claims could not be reviewed for prior art because the claims are non-statutory. The Examiner stated that the references used in the previous Office Action should be used for guidance.

In items 5 and 6 on page 2-4 of the August 24, 2003 Office Action, the Examiner rejected claims 1-8 under 35 U.S.C. § 102(e) as being anticipated by Hennessey et al. (U.S. Patent No. 6,483,938). Applicants respectfully traverse these rejections for the reasons presented below.

Claim 1 recites, as amended, “storing in a knowledge database ... correlation levels showing a degree of correlation between the causes and corresponding questions ... extracting certain questions from the plurality of questions using an algorithm based on the correlation levels; displaying the certain questions to a user; receiving answers from the user corresponding respectively to the certain questions; and extracting causes with high correlation levels from the plurality of causes based on the answers from the user.” Independent claims 5 and 9 recite language similar to that of claim 1.

In Hennessey, a digital image of a product having an anomaly is generated and the anomaly is isolated on the image. The anomaly is compared with stored images of known anomalies in a knowledge database to find a stored image having a maximum similarity.

The Examiner asserted in the August 24, 2003 Office Action that the “questions” of the present invention are synonymous with the “anomalies” of Hennessey. However, it is submitted that a question and an anomaly do not have the same meaning. Hennessey merely discloses comparing data stored in the knowledge database with the captured image data, and using an algorithm to extract data that are most similar to the captured image data from the knowledge database. Thus, Hennessey does not disclose “displaying the certain questions to the user; receiving answers from the user corresponding respectively to the certain questions; and extracting causes with high correlation levels from the plurality of causes based on the answers from the user,” as recited in claim 1.

Also, the Examiner asserted in the August 24, 2003 Office Action that the “degree of correlation” of the present invention is established by the “maximum similarity” of Hennessey.

However, the degree of correlation between causes and questions in the present invention is not determined based on a comparison between an image and sets of known anomalies in a knowledge base. In the present invention, the degree of correlation refers to how closely a question relates to a specific cause. Furthermore, Hennessey does not teach "storing in a knowledge database ... correlation levels showing a degree of correlation between the causes and corresponding questions," as recited in claim 1.

Therefore, it is submitted that independent claims 1, 5, and 9 patentably distinguish over the prior art. As for the dependent claims, the dependent claims depend from the above-discussed independent claims and are patentable over the prior art for at least the reasons discussed above.

Therefore, Applicants submit that claims 1-12 patentably distinguish over the prior art. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under § 102.

### **Conclusion**

In accordance with the foregoing, it is respectfully submitted that all outstanding rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding rejections, the application is submitted to be in condition for allowance, which action is earnestly solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

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Finally, if there are any additional fees associated with filing of this response, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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